Remarks

Claims 1-24 are pending in this application. Claims 8 and 22-24 have been withdrawn as drawn to non-elected Groups. Claims 1, 2, 5, 7 and 11 have been amended. Claims 4 and 14-21 have been canceled. Applicants expressly reserve the right to pursue protection of any or all of the subject matter of the canceled claims in a subsequent application.

Support for claims amendments can be found throughout the specification, including, at least, page 12, lines 5-7 and page 15, lines 5-10. No new matter is introduced by these claim amendments.

Upon entry of the foregoing claim amendments, **claims 1-3, 5-13 and 22-24 will be pending in this application**. Reconsideration and allowance of the pending claims are requested.

Telephone Interview:

Applicants thank Examiner Calamita for the courtesy of a telephone interview with their representative, Karri Kuenzli Bradley, on December 20, 2007. During the telephone interview, the pending 35 U.S.C. §102(e) rejection was discussed. In particular, the amendment of claim 1 to be directed to a method for analyzing the transcriptome of a tissue section which preserves the 2-dimensional architecture of molecules present within a tissue section was discussed. Applicants' representatives noted that none of the cited art teaches or suggests such a method.

Complete agreement on claim amendments or arguments for overcoming the pending rejection was not reached; however, the Examiner provided helpful guidance and agreed to consider claim amendments and arguments filed by Applicants in a response to the Office action. It is believed that this Amendment conforms to the spirit of the discussion had during the telephone interview.

Rejections under 35 U.S.C. §102(e)

Claims 1-7 and 9-14 have been rejected under 35 U.S.C. §102(e), as allegedly anticipated by Warrington *et al.* (U.S. Patent Publication No. US 2001/0044104 A1; hereinafter Warrington *et al.*). Applicants respectfully traverse this rejection for at least the following reasons.

To establish anticipation, each and every element of the claimed invention must be disclosed in a single prior art reference (*Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Claims 1, 2, 4-7 and 9-13 are not anticipated by Warrington *et al.* at least because Warrington *et al.* do not disclose a method for analyzing the transcriptome of a tissue section in which method preserves "the 2-dimensional architecture of the molecules present within the tissue section" and thus, allow "a determination of the location(s) in the tissue section in which said two or more molecular species are present," as presently required by the claims.

Warrington *et al.* identify gene expression differences to diagnose disease. For example, Warrington *et al.* provide methods for diagnosing a disease that involve the comparison of expression profiles obtained from matched experimental samples to identify differential gene expression. Warrington *et al.* do not utilize an External Movement Inhibitor device (or any other mechanism or device) that preserves the 2-diminesional architecture of the molecules within a tissue section to permit the determination of the molecule location(s) in the tissue section. The Office contends that the microwell array utilized in Warrington *et al.* "serves as an external movement inhibitor because the partition prevents the movement of the RNA on the array" (Office action, page 3). The Office further contends that such partition "keeps the RNA in one or more discrete regions on the membrane and permits determination of the location of the cDNA probes (molecular species) on the array." *Id.* As discussed with Examiner Calamita, Warrington *et al.* disclose an array; they do not disclose any device that preserves "the 2-dimensional architecture of the molecules within a tissue section" and thus, allow the determination of the location of the molecules in a tissue section, as is required by the present claims.

For example, Warrington *et al.* fail to disclose an External Movement Inhibitor device "having multiple discrete partitions, wherein the multiple discrete partitions comprise at least one of a plurality of grids or a plurality of wells, whereby each grid or well sequesters molecules corresponding to a specific region or cell type of the tissue section" as presently claimed. The ability of the Applicants' External Movement Inhibitor device to preserve the 2-dimensional architecture of molecules present within a tissue section is one of the advantageous features of the present invention. This allows the

determination of the location of the molecules in a tissue section. Without this element, Warrington *et al.* do not disclose a method for analyzing the transcriptome as presently claimed and cannot anticipate the claims.

As Warrington *et al.* do not properly anticipate the current claims, Applicants respectfully request that the rejection under 35 U.S.C. §102(e) for claims 1, 2, 4-7 and 9-13 be withdrawn.

Request for Rejoinder

Applicants thank the Examiner for recognizing that claim 1 is a generic claim (Restriction Requirement, November 29, 2006). Thus, Applicants request that withdrawn claims 8 and 22-24 be rejoined as provided by 37 CFR 1.141.

Conclusion

Applicants respectfully submit that the claims submitted herewith are in condition for allowance. If any issues impede the issuance of a notice of allowance, the Examiner is requested to contact the undersigned prior to the mailing of a subsequent action in order to arrange a telephone interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution and allowance of the claims.

Respectfully submitted,

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